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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,360	08/27/2001	Jeff M. Anderson	10018309-1	5091

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HEWLETT-PACKARD COMPANY
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EXAMINER

VU, TUAN A

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,360

Applicant(s)

ANDERSON ET AL.

Examiner

Tuan A. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 11/22/2004.

As indicated in Applicant's response, claims 1, 7, 13 have been amended and claims 16-20 canceled. Claims 1-15 are pending in the office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 7, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the automatic hardware installation initiation being performed without user interaction, a critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims 1 and 13 recite 'suppressing an automatic installation mode for the device initiated by an operating system of the computer, without user interaction, upon the device being connected to the computer prior to the software being completely installed on the computer'. Claiming a feature that is not present requires substantial supporting disclosure showing why such feature not being there is essential and how it is implemented. The limitation as to not using user interaction in regard to suppressing of an automatic mode is not disclosed clearly in the specifications in order to enable this limitation to be used or made by a skill in the art. Specifically, the disclosure shows options to the user to select files (pg. 9, middle para), re-initiating of a installation mode if a device has not been inserted (pg. 9, bottom); instructions for

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the user to plug the device (pg. 10, middle). Further, Figure 5 and related text disclose closing a window based on comparing of string attributes, e.g. 'once the automatic ... suppression starts ... any window that is created is detected ... detection of this window allows ... installation mode ... to be suppressed ... by closing the window (pg. 10, bottom, pg. 11, top). Apparently the Fig. 5 teaching has no connectivity with a device being connected to a computer; and if it does then the 'without user interaction' would have been contradictory. Thus, the fact of closing the window (as from steps 500, 504 Fig. 5) being disjoint from or lacking connective specifics to the combination recited as 'without ...interaction' and 'upon the device being connected to the computer prior to ...' do not convey a reasonable understanding as to how such closing/suppressing step can be enabled by a skill in the art. It is noted that the string comparing step (pg. 11, 2nd para) of Fig. 5 and subsequent comparing and/or closing are understood as to be necessarily in conjunction with the recited detection of insertion of a device, which inherently requires some manual insertion by an user. The combined features such recited as 'suppressing', 'without ...interaction', 'upon ... device being connected to the computer' in light of the disclosed steps of comparing and closing do not amount to a clear teaching for a reasonable enablement of the invention; and one skill in the art would not be able to make or make use of such combination which is not only missing in the claims but lack clear reasonable teachings from the disclosure.

Claim 7 discloses the program product with method steps of

- a) installing ... , and while installing,
- b) detecting ...,
- c) determining ...; and

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d) closing, without user interaction.

From the specifications as mentioned above, the method of installing software as disclosed encompasses teaching allowing user to select files, to insert a device, starting a automatic hardware installation step (step 500); and a comparing step for closing a window in a virtual transparent way to an user' eye (see pg. 9-11) to exit an automatic mode. Claiming a feature that is not present requires substantial supporting disclosure showing why such feature not being there is essential and how it is implemented. There is no teaching from the above pages that clearly points out that the 'without user interaction' limitation in step d) is being implemented -- while the installing step a) is still running--, or performed such that it achieve the absence of user interaction. Specifically, there is no clear teaching in the disclosure that particularly shows step d) as achieving the result of not needing user interaction when such step is integral to a particular software program – step a - which while running entails a form of user interaction. The very fact of starting step 500 in Fig. 5 implies a user action and choice (see pg. 9-11 of disclosure). The alternate scenario is that if the suppressing step (or step d) is without user interaction, then any window that is taken away by an underlying interface code execution is considered without user interaction; and this limitation would have no weight in light of prior art such as those teaching window widget being closed up. Further, when a software product has been initiated and executed by an user, the fact of claiming that the effects of such execution are without user interaction (automated versus manually, absent versus present) in a particular context does not add a patentable weight unless provision in the disclosure and claims clearly describe how such execution has been accomplished in order to preclude any user intervention under specific settings. Refer to the following:

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In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)
The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

And the disclosure does not provide this sufficient teaching to establish an automated process as opposed to a manually process requiring a user. It is noted that step 500 of Fig. 5 implies user intervening and page 11 does not link this closing step 504 with a particular software element distinct (emphasis added) from that of step 500, i.e. there is lack of one software utility or enabling product that can be tangibly construed as independent from step 500 about which absence of user interaction is not evident. In other words, the disclosure fails to point out why such closing as in step d during the context of user-driven installation as in step a can be performed without user interaction when step d would not have existed if step a is not decided by an user to take action. The combined steps a, b, c, d therefore in light of what is in the disclosure fail to provide teaching as to enable one skill in the art to make or make use of the invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 7, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims 1 and 13 recite 'without user interaction' but there is indefinite teaching as whether this requirement applies to the suppressing limitation or to the automatic mode initiation limitation in light of the following requirement recited as 'upon the device being connected to the computer ...'. This indefinite language will lead to 2 interpretation of this limitation: either

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such absence of user interaction is applied to 1) the automatic initiation by the operating system; or 2) the underlying code suppressing a mode or an interface component after the suppressing command has been triggered or initiated by an user.

Claim 7 also recites 'without user interaction' but virtue of the USC 112, 1st paragraph rejection from above, this limitation is treated as though the user interaction is solely for the initiating step recited as 'installing software on the computer ... and while installing' from above; while the absence of user interaction is realized during the process of suppressing a window by the underlying software execution which has been triggered by the above initiating step as mentioned above in 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fida International, "ProLink Hurricane 8000 ADSL Modem", *User's Manual*, VER. 1.5, 2000, pp. P1-P26 (hereinafter Fida) in view of Polycom, "ViaVideo User's Guide", *ViaVideo QuickStart*, Nov. 2000, (hereinafter Polycom).

As per claim 1, Fida discloses a method for installing software on a computer for a device to be connected to the computer and performing one or more actions selected from the group of actions consisted of:

while installing the software, suppressing an automatic mode for the device initiated by an operating system of the computer without user interaction upon the device being connected to the computer prior to the software being completely installed thereon (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying software that takes away a *CANCEL* button reads on not requiring user interaction); and

But Fida does not disclose instructing a user to connect the device to the computer after installing the software. The activation of a device being connected to the computer after installation of its pertaining software as disclosed by Fida suggests the motivation to ensure that the hardware device be connected in order for the installation to fully succeed and the device to get activated. Polycom, in a installation method of device being connected to a computer analogous to Fida wherein device driver or software components have to be installed first, discloses instructing the user to connect the device after the software has been installed (e.g. *Installing Hardware* - pg. 2). It would have been obvious for one of ordinary skill in the art at the time the invention was made to provide to the installation process by Fida so that there is a provision requesting the user to connect the device after the step of installing the drivers is completed because the purpose is to prepare those drivers for the device to be properly installed/activated; and it is necessary that the user ensure that the device for which the driver is intended be connected for the installation to achieve such purpose.

Fida does not explicitly disclose that after installing the software on the computer, initiating the automatic installation mode for the device without having the computer rebooted. However, the concept of initiating the installation mode without having to reboot is evident when Fida applies the Plug and Play mode to initiate the installation mode because it is known in the

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art that Plug-and-Play enable installation of device being plugged on a running environment without having to restart the computer (section 3.1.2 P10 – Note: Plug&Play mode so that after copying the driver files and implicitly initiating a mode in the installation system, e.g. registry setting, so that the computer will be ready to activate and configure the installed Prolink device even before any restart takes place reads on initiating the installation mode without having to reboot). With the emphasis that initiating a mode is being interpreted as setting up a mode of installation through a Plug-and-Play process and that such mode when eventually executed would include configuring and activating the device, e.g. after a restart, the step of ‘initiating an installation mode without reboot’ is therefore disclosed by Fida.

As per claim 2, Fida discloses user manually initiating (e.g. steps 1, 2, 3 – section 3.1.2 P10

As per claim 3, Fida discloses inserting of a media (e.g. step 2, section 3.1.1 or step 2, sec 3.1.2)

As per claim 4, Fida discloses detecting a window, whether it is related to installation, related to automated mode, and closing the window (e.g. *CANCEL* – section 3.1.1 pg. P7)

As per claim 5, Fida discloses initiation of installation mode (re claim 1); and also re-enumeration routine of the computer system (e.g. P14, P16 Note: initiating the re-enumeration process via Plug-and-Play and enumeration data displayed to user thereafter as a result of the execution of such initiating step amounts to initiating installation mode by inherently calling re-enumeration routines).

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As per claim 6, in view of the teachings by Polygon's using a GUI installation with interactive type buttons waiting for mouse-click events, this waiting for the user to confirm would have been obvious for the same grounds as set forth in claim 1.

As per claim 7, Fida discloses a computer medium with computer instructions to perform a method comprising:

installing software for a device to be connected to a computer (e.g. section 3.1 p. P6) and while installing the software,

detecting a window, whether it is related to installation, related to automated mode, and closing the window (e.g. *CANCEL* – section 3.1.1 pg. P7 – Note: the act of triggering a closure by the user reads on detecting and closing to exit an installation mode)

But Fida does not explicitly teach that the closing of window is without user intervention but following the teaching that *CANCEL* button by Fida, the underlying software that takes away this *CANCEL* button, i.e. the act of actually closing such button widget by a code, reads on not requiring user interaction while closing as to exit an installation mode.

As per claims 8-10, the steps of associating variables or attribute to a button due to OS automatic detection of device within a window, such window having OS attributed handle, or some string identification imparted to such handle; and setting an countermanding action (a flag) upon the detection of such identification are all features inherent to Windows operating system and underlying process for identifying components and their handles; therefore the detecting of window with *CANCEL* button as disclosed by Fida implicitly disclose the attribute, string resources, a flag identifying a automatic mode of claims 8-10.

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As per claim 11, Fida discloses re-initiate the installation by detecting a CANCEL button (*CANCEL* – section 3.1.1 pg. P7) with its inherent window handle associating with a click on the CANCEL button; and also discloses a plug-and-play mode wherein automatic mode of installation keeps on proceeding (section 3.1.2), hence has disclosed appropriate action based on the window flag (plug-and-play flag versus automatic mode flag) as addressed in claim 10.

As per claim 12, refer to claim 5.

As per claim 13, Fida discloses a point of sale device package comprising: a device to be connected to a computer via a connector of the device coupling to a corresponding connector of the computer (sec 2.1 – pg. P4) and means for suppressing an automatic mode for the device initiated by an operating system of the computer without user interaction upon the device being connected to the computer prior to the software being completely installed thereon (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying software that takes away a CANCEL button reads on not requiring user interaction).

As per claim 14, Fida discloses a communication device (sec 2.1 – pg. P4 – Note: Modem being able to act as an signal processor for phone, PC, or a router is equivalent to a multi-function device); whereas Polygon discloses a camera (ViaVideo), both requiring USB port and installation of software first. It would have been obvious to combine the teachings of Fida and Polygon so that the device can also be a camera with the same benefits as taught from the rationale used in claim 1; because the more devices an invention can apply to the more marketable the product becomes.

As per claim 15, Fida discloses USB and IEEE-1394 (e.g. sec 2.1 – pg. P4 – Note: Modem and IEEE-1394 were inter-compatible technologies at the time the invention was made).

Response to Arguments

8. Applicant's arguments filed 1/22/2004 have been fully considered but they are not persuasive. Following are the Examiner's observation thereto.

Claim rejections under 35 USC 103:

(A) Applicants have submitted that Fida in view of Polycom does not disclose the suppression of an automatic installation mode without user interaction and that Fida teaches a 'click cancel' to suppress the automatic mode of installation (Appl. Rmrks, pg. 7). The limitation 'without user interaction' is not disclosed sufficiently in the disclosure or in the claims to enable how this suppression as recited can be implemented or made use of by a skill in the art; and this deficiency has been put forth in the above USC 112, 1st para rejection. The limitation therefore has been interpreted based on most reasonable and broad construction in light of the skill level in the art of the examiner. And as mentioned in the USC 112, 2nd para rejection, this 'without user interaction' has been construed or treated as the automated aspect of the underlying execution code triggered to take away a window widget when such widget is suppressed from the installation screen interface. And such automated suppression by means of software code is a process not requiring user interaction.

Besides, claiming a feature for being automated as opposed to manually performed without support of such automated process in the claim or disclosure does not give that feature any patentable weight. And claiming a non-existing/absent feature without disclosing clearly why such non-existence would be essential and without substantial disclosure support therefor is also not allotting such feature with any patentable weight.

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In all, the disclosure does not provide enabling support as to how this 'without user interaction' is implemented; and in light of what has been used to interpret this limitation, the teaching of Fida or any manually executed process performed by the user to cancel the automatic mode of installation reads on this limitation. And the rejection has pointed out why it is so.

(B) Applicants have submitted that Fida in view of Polycom does not disclose or render obvious the suppression of an automatic installation mode without user interaction based on the button clicking and a user manuals of the reference (Appl. Rmrks, pg. 7, bottom, pg. 8, middle). These arguments fall under the assumption that the 'without user interaction' limitation as claimed has some weight and that it is clearly supported by the invention specifications. And this is not true by virtue of the 35 USC 112 rejections from above. Hence, these arguments are not persuasive in light of the rationale as set forth in section A above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

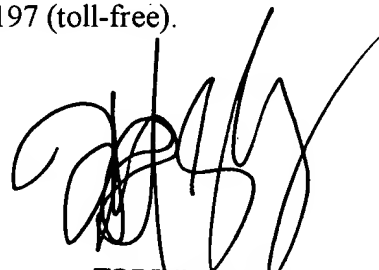
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence – please consult Examiner before using) or 703-872-9306 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
May 4, 2005



TODD INGBERG
PRIMARY EXAMINER